

112.P77195

Patent**REMARKS**

The above-referenced patent application has been reviewed in light of the Office Action referenced above. Reconsideration of the above-referenced patent application in view of the following remarks is respectfully requested.

Claims 1-3, 8, 12-16, 18, 20, 23-24, and 27-28 are currently pending. Claims 4-6, 9-11, and 19 were previously withdrawn. Claim 29 has been amended. No new matter has been added. The amendments to the claims are made without prejudice or disclaimer. Consideration of this response is respectfully requested.

Claim Rejections Under 35 U.S.C. §112

In the office action, the Examiner has rejected claim 29 as being indefinite for duplicating limitations present in independent claim 1.

In response, Assignee has removed the duplicative language from claims 29.

Claim Rejections Under 35 U.S.C. §103(a)

In the office action, claims 1, 8, 12-13, 23-24, and 27-28 are rejected under 35 U.S.C. §103(a) as being unpatentable over Saari et al., U.S. Patent No. 6,532,035 (hereinafter "Saari") in view of Kuroda, U.S. Patent Application Publication No. 2003/0036365 (hereinafter "Kuroda") and Belliveau, U.S. Patent Application Publication No. 2004/0114043 (hereinafter "Belliveau"). Claims 2-3 are rejected under 35 U.S.C. §103(a) as being unpatentable over Saari in view of Kuroda and Belliveau and in further view of Motta et al., U.S. Patent No. 6,809,772 (hereinafter "Motta"). Claims 14-18, 20, and 25-26 are rejected under 35 U.S.C. §103(a) as being unpatentable over Saari in view of Motta and Belliveau.

112.P77195

Patent

Assignee respectfully submits the Examiner has not established that the cited references disclose all of the elements of independent claim 1. The Examiner is kindly reminded that the Examiner's initial burden of factually supporting any *prima facie* conclusion of obviousness includes that:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (MPEP § 2143.03.)

For example, Examiner has not established that the proposed combination discloses:

a reflector module installed in the housing capable of reflecting the light input from the lens, the reflector module comprising:
a pedestal capable of turning on a second axis;
a reflector installed on a side of the pedestal capable of selectively reflecting light from the first hole or the second hole to a photosensor installed in the housing; and
a strobe installed on the pedestal capable of turning with the pedestal (emphasis added)

as recited in claim 1. In the present Office Action, the Examiner points to items 84 and 86 of Saari as disclosing a pedestal and a reflector as claimed, stating:

For claim 1, Saari discloses ...
a pedestal capable** of turning (86) on a second axis (col. 7, lines 22-36);
a reflector (84) installed on a side of the pedestal capable of** selectively reflecting light from the first hole or the second hole to a photosensor installed in the housing (col. 7, lines 22-36 and fig. 5); ...
(See page 4 of the Office Action)

As previously asserted by the Assignee, Assignee does not concede that a pivot discloses a pedestal. Further, the pedestal of claim 1 comprises a side capable of having installed thereon a reflector. However, pivot 86 as shown and described in Saari does not appear to include a side capable of having installed thereon a reflector. Likewise, the pedestal of claim 1 comprises a pedestal capable of having installed thereon a strobe. In response, the Examiner has asserted that:

In col. 7, lines 22-36, Saari's pedestal is called a pivot, which allows the reflector to have pivotal (turning) movement. (See page 3 of the Office Action)

112.P77195

Patent

Assignee cannot agree. Specifically, the Examiner has not replied to Assignee's argument that the pivot 86 of Saari is insufficient to read on the claimed "pedestal", as the pedestal of claim 1 comprises a side capable of having installed thereon a reflector. Likewise, the Examiner has not replied to Assignee's argument that the pivot 86 of Saari is insufficient to read on the claimed "pedestal", as the pedestal of claim 1 comprises a pedestal capable of having installed thereon a strobe. The pivot of Saari clearly would not support the installation of a strobe on the pivot, and certainly no such structure is disclosed. Thus, contrary to the Examiner's assertion, Saari does not disclose a "pedestal" as is claimed in claim 1. Kuroda, Belliveau, and Motta also fail to disclose a pedestal as claimed in claim 1. In the absence of the Examiner pointing to such a disclosure in the cited references, Assignee requests that the rejection be withdrawn as the Examiner failed to establish that the cited references render obvious all of the features of claim 1.

Second, Assignee respectfully submits the Examiner has not established that the cited references disclose all of the elements of independent claim 1 as the Examiner has not established that the proposed combination discloses:

a strobe installed on the pedestal capable of turning with the pedestal...

as recited in claim 1. In the present Office Action, the Examiner attempts to cure the failure of Saari to disclose a strobe as claimed by pointing to items 345 of Belliveau, stating:

Additionally, Saari does not disclose a strobe installed on the pedestal and capable of** turning with the pedestal to allow the strobe to be aimed substantially parallel with the first central axis in either direction for providing a light source for the digital image capturing apparatus. In a similar field of endeavor Belliveau discloses a digital image capturing apparatus wherein the reflector module (figs. 3/5, ref. 230) comprises: a strobe (345) installed on a pedestal (225) and capable of** turning with the pedestal (pg. 3, pgph. 33) allowing the strobe to be aimed substantially parallel (380) with the first central axis (351) in either direction for providing a light source for the digital image capturing apparatus (pg. 4, pgph. 39); ... (See page 5 of the Office Action)

112.P77195

Patent

Further, the mobile communication terminal 10 may optionally include an infrared communication port or transmitter 46 for transferring information to and from the mobile communication terminal 10 and which infrared port may also direct illumination to the object being scanned.

Assignee cannot agree. Specifically, Assignee submits that the Examiner has not established that the propose combination teaches or suggests "*a strobe installed on the pedestal capable of turning with the pedestal*" as recited in claim 1. First, Assignee submits that Saari does not disclose any device that could be considered a "strobe", as claimed. Further, Assignee submits that Saari teaches away from the proposed combination by associating an illumination device 46 only with lens 36 and not with both lens 36 as well as lens 32. For example, Saari discloses:

Further, the mobile communication terminal 10 may optionally include an infrared communication port or transmitter 46 for transferring information to and from the mobile communication terminal 10 and which infrared port *may also direct illumination to the object being scanned*. (See col. 5, lines 16-21, emphasis added)

As no other illumination device is discussed as desirable for lens 32, Saari appears to teach away from the proposed combination, as Saari only recognizes a need for illumination for a single lens. Further, Assignee submits that Belliveau appears insufficient to overcome the failings of Saari. Specifically, it appears to the Assignee that in Belliveau the entire lamp housing 230 (including the lamp 345, lens 351, and camera 364) are all fixed within the housing 230, and do not turn with respect to one another. For example, Belliveau discloses:

The components within or part of the lamp housing 230 include a filter assembly 342, a mirror 344, a projection lamp or projection light source 345, a light valve 346, a condensing lens 347, a filter assembly 349, a focusing lens 351, a camera 364, and an aperture 370. (See para. [0034], emphasis added)

As Belliveau discloses lamp 345 being fixed within housing 230, Assignee submits that Belliveau also teaches away from the claimed invention. Accordingly, Assignee submits that the Examiner has not established that any of the cited references, alone or in combination, teach or suggest "*a strobe installed on the pedestal capable of turning with the pedestal*" as recited in claim 1. In the absence of the

112.P77195

Patent

Examiner pointing to such a disclosure in the cited references, Assignee requests that the rejection be withdrawn as the Examiner failed to establish that the cited references render obvious all of the features of claim 1.

Third, the Examiner has asserted that the Examiner will not give any limitation with "capable of" language patentable weight (see page 16 of the Office Action). Assignee cannot agree. Assignee has described the structural limitations here by requiring a structure capable of performing the claimed operation. The Examiner is kindly reminded that a **functional limitation** cannot be read out of the claims and must be taught by the reference, as stated in the MPEP that:

A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step. (See MPEP § 2173.05(g), emphasis added.)

Accordingly, Assignee submits that the Examiner is obligated to cite to some structure in the references that is structurally capable of performing the claimed functions to establish that the cited references render obvious all of the features of claim 1. As the Examiner has not given any feature reciting "capable of" language any patentable weight, Assignee requests that the rejection be withdrawn as the Examiner failed to establish that the cited references render obvious all of the features of claim 1.

Claims 14 and 28 include similar limitations. Therefore, claims 1, 14, and 28 and the claims that depend from them are patentably distinguished over the cited documents. Assignee respectfully requests that the Examiner withdraw his rejections to the aforementioned claims.

112.P77195

Patent

Fourth, Assignee respectfully submits the Examiner has not established that the cited references disclose all of the elements of independent claim 14. For example, Examiner has not established that the proposed combination discloses:

a lens installed on the housing, wherein the lens is capable of moving between a first position and a second position, capable of receiving light from the front of the housing in the first position and from the rear of the housing in the second position;

a reflector module installed in the housing capable of reflecting the light input from the lens, the reflector module comprising:

a pedestal capable of turning on an axis;

a reflector installed on a side of the pedestal capable of reflecting light from the lens to the photosensor; (emphasis added)

as recited in claim 14. In the present Office Action, the Examiner points to items 32 and 116 of Saari as disclosing a lens and a reflector module as claimed, stating:

For claim 14, Saari discloses ...

a lens (32) installed on the housing, wherein the lens is capable of** moving between a first position and a second position, capable of** receiving light from the front of the housing in the first position and from the rear of the housing in the second position (col. 4, lines 41-46; col. 5, lines 27-47);

a reflector module (116) installed in the housing for reflecting the light input from the lens (col. 6, lines 10-18), the reflector module (fig. 10) comprising:

a pedestal capable** of turning (Saari, fig. 10, ref. 86) on a second axis (Saari, col. 7, lines 22-27);

a reflector (Saari, fig. 10, ref. 84) installed on a side of the pedestal capable of** selectively reflecting the light from the lens to a photosensor installed in the housing (col. 7, lines 22-36 and fig. 5); ... (See page 4 of the Office Action)

Assignee cannot agree. Specifically, Assignee submits that the Examiner has proposed combining several separate and distinct embodiments of Saari that themselves teach away from such a combination. Here, the Examiner has cited to flat mirror reflector 116 from the embodiment illustrated in Fig. 5 of Saari as reading on the claimed "reflector module" with a turnable "pedestal" while conversely citing to lens 32 from the embodiments illustrated in Figs. 1-3 of Saari as reading on the claimed movable "lens".

112.P77195

Patent

However, the embodiment illustrated in Fig. 5, cited by the Examiner as reading on the claimed “*reflector module*”, teaches away from a combination with a movable lens, stating:

Turning now to FIG. 5, a further embodiment of the mobile communication terminal embodying the present invention is shown therein and generally designated 100. The mobile communication terminal 100 is substantially similar to the mobile phones illustrated in FIGS. 1-4. However, the camera assembly generally designated 102 is fixed, that is, the camera assembly 102 does not rotate in the mobile phone. The camera assembly 102 is substantially identical to the camera assembly 20 described above in all other aspects and includes a camera body 104 and a main camera lens comprising the image capturing means and lens portion 106 carried by the camera body 104. (See col. 5, line 60 to col. 6, line 4 of Saari, emphasis added)

Here the camera assembly 102 with lens 106 from the embodiment illustrated in Fig. 5 of Saari corresponds with the camera assembly 20 with lens 32 from the embodiments illustrated in Figs. 1-3 of Saari; however, Saari explicitly states that the camera assembly of the embodiment illustrated in Fig. 5 cited by the Examiner as reading on the claimed “*reflector module*” is fixed. From this description in Saari, it appears that the use of flat mirror reflector 116 from the embodiment illustrated in Fig. 5 of Saari is a mutually exclusive alternative to the rotatable lens 32 from the embodiments illustrated in Figs. 1-3 of Saari. Accordingly, Assignee submits that Saari teaches away from the Examiner’s combination of embodiments. Additionally, Assignee submits that Motta does not cure Saari as the Examiner has not asserted nor established that the lens (25/26) of Motta is disclosed as “*capable of receiving light from the front of the housing in the first position and from the rear of the housing in the second position*” as recited in claim 14. Conversely, reference to Fig. 2 of Motta illustrates that lens (25/26) of Motta appears to only be linearly moveable along a portion of the primary light path to help to focus light. In the absence of the Examiner pointing to such a disclosure in the cited references, Assignee requests that the rejection be withdrawn as the Examiner failed to establish that the cited references render obvious all of the features of claim 14. Therefore claim 14 and the claims that depend

*112.P77195**Patent*

therefrom are patentably distinguished over the cited documents. Assignee respectfully requests that the Examiner withdraw his rejections to the aforementioned claims.

It is noted that claimed subject matter may be patentably distinguished from the cited references for additional reasons; however, the foregoing is believed to be sufficient. Likewise, it is noted that the Assignee's failure to comment directly upon any of the positions asserted by the Examiner in the office action does not indicate agreement or acquiescence with those asserted positions.

112.P77195

Patent

Conclusion

In light of the foregoing, reconsideration and allowance of the claims is hereby earnestly requested.

Any fees or extensions of time believed to be due in connection with this amendment are enclosed herein; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account 50-3703.

Invitation for a Telephone Interview

The Examiner is invited to call the undersigned attorney, James J. Lynch, at (503) 439-6500 if there remains any issue with allowance.

Respectfully submitted,
Attorney for Assignee

Date: October 26, 2007

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